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NOTE: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public order.

U.S. PATENT & TRADEMARK OFFICE

Donnelly, Isaacson

United States Court of Appeals for the Federal Circuit

MISCELLANEOUS NO. 547

IN RE PARAGON SERVICES INTERNATIONAL, INC.,

Petitioner.

ON PETITION FOR WRIT OF MANDAMUS

Before MICHEL, RADER, and BRYSON, Circuit Judges.

RADER, Circuit Judge.

ORDER

Paragon Services International, Inc. submits a petition for a writ of mandamus to direct the Commissioner of Patents and Trademarks to supervise an examiner who is involved with certain patent applications filed by Paragon. The Commissioner opposes. Paragon submits a reply.

BACKGROUND

This matter concerns three related patent applications, which we briefly discuss. The original patent application was filed in 1992. It was later abandoned. The second application was filed in 1994 as a continuation-in-part of the earlier application. It has been twice rejected and an appeal concerning that application is now pending before the Patent and Trademark Office, Board of Patent Appeals and Interferences. In the meantime, the third application was filed as a continuation application of the second

application.* On December 30, 1997, the examiner rejected all of the pending claims of the third application.

On January 12, 1998, Paragon petitioned the Commissioner to exercise his supervisory authority over the examiner with respect to the second and third applications. See 37 C.F.R. § 1.181. On April 22, 1998, the Commissioner dismissed the petition. The Commissioner dismissed the allegations concerning matters related to the denial of the second application, the appeal of which is pending before the Board, as untimely. With respect to the third application, the Commissioner stated that the allegations concerned issues appealable to the Board and thus were not petitionable. Paragon's mandamus petition to this court followed.

DISCUSSION

Paragon seeks a writ of mandamus to direct the Commissioner to exercise his supervisory authority over an examiner who, according to Paragon, "has delayed issuance of a patent for six years by relying on references that are not and cannot be prior art, and are admitted by the Examiner to be later, not prior art." Further, although Paragon states in its mandamus petition that one of the issues presented therein concerns whether this court has supervisory authority over the Commissioner, Paragon does not explicate the statement. In essence, Paragon's arguments concern whether the examiner was correct in rejecting claims based on certain references.

* On July 2, 1997, Paragon filed in this court a petition for a writ of mandamus to direct the Commissioner to issue a decision in the appeal of the second application or to issue a decision with respect to Paragon's "Petition to Make Special" concerning the third application. Paragon later withdrew its mandamus petition when the petition to make special was granted.

The Commissioner contends that this court does not have jurisdiction to issue a writ of mandamus to him and that, in any event, mandamus is not necessary or appropriate to aid this court's prospective jurisdiction. See Will v. United States, 389 U.S. 90, 97 (1967) (mandamus may not be used as a substitute for an appeal).

We agree with the Commissioner that Paragon is not entitled to mandamus relief. As the court stated in In re Makari, 708 F.2d 709, 711 (Fed. Cir. 1983), "[o]ur jurisdiction in relation to the Patent and Trademark Office is limited to review of decisions of boards established in the Office. We do not have jurisdiction to review decisions of the Commissioner on petitions." In that case, like the case here, the petitioner was in effect seeking review of the rejection of the claims of an application, a matter appealable to the Board and, if appropriate, to this court. In sum, Paragon's petition must be dismissed.

Accordingly,

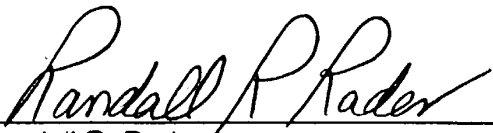
IT IS ORDERED THAT:

The petition for a writ of mandamus is dismissed.

FOR THE COURT

JUL - 7 1998

Date


Randall R. Rader
Circuit Judge

cc: Nancy J. Linck, Esq.
John P. Sutton, Esq.

s11

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JUL - 7 1998

JAN HORBALY
CLERK